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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/019,117	05/17/2002	Ronald C Stefaneck	SFK 20002 US	7799

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EXAMINER

GOETZ, JOHN S

ART UNIT	PAPER NUMBER
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3725

DATE MAILED: 08/01/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/019,117

Applicant(s)

STEFANEK, RONALD C

Examiner

John S. Goetz

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 17 May 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☒ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 2.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

Specification

1. The specification is objected to under 37 C.F.R. 1.71 as not clearly describing the subject matter of the invention. Specifically, the specification refers to “steels.” The use of this word is confusing. Steel, when used as a noun, means: “[a] generally hard, strong, durable, malleable alloy of iron and carbon, usually containing between 0.2 and 1.5 percent carbon, often with other constituents such as manganese, chromium, nickel, molybdenum, copper, tungsten, cobalt, or silicon, depending on the desired alloy properties, and widely used as a structural material.”¹ Applicant appears to be using the word “steel” to mean “die,” or “forming surface,” or “hemming blade,” or the like. This unusual use of the word is needlessly confusing. Appropriate correction is required.

Claim Rejections - 35 USC § 112

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 1, 3, 5, 6, 7, 11, 12, 14, 15, 16, 18, 20, 22, 23, and 28 rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

4. Where applicant acts as his or her own lexicographer to specifically define a term of a claim contrary to its ordinary meaning, the written description must clearly redefine the claim term and set forth the uncommon definition so as to put one reasonably skilled in the art on

¹ *The American Heritage® Dictionary of the English Language, Third Edition* copyright © 1992 by Houghton Mifflin Company. Electronic version licensed from INSO Corporation; further reproduction

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notice that the applicant intended to so redefine that claim term. *Process Control Corp. v. HydReclaim Corp.*, 190 F.3d 1350, 1357, 52 USPQ2d 1029, 1033 (Fed. Cir. 1999). The term “steel” is used by the claim to mean “forming die” or “forming tool” or the like, while the accepted meaning is “[a] generally hard, strong, durable, malleable alloy of iron and carbon.”² The term is indefinite because the specification does not clearly redefine the term.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-5, 7-9, 18-20 and 22-24 are rejected under 35 U.S.C. 102(b) as being anticipated by Hirabayashi (JP 01-249257 A).

7. Regarding claims 1-5 and 7-9, Hirabayashi discloses a hemming apparatus comprising (see Figs. 8A-8C):

- i. an anvil with a horizontal “supporting surface” (4) and a sloped surface (1);
- ii. an upper body (5);
- iii. a forming or hemming die (6) comprising:
 - a. a first angled surface (6b);
 - b. a second angled surface (6a);
- iv. wherein the first angled surface is “defined” at substantially the same angle as the sloped side of the anvil (see Figs. 8A-8C);

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- v. a cam (13) and a cam roller (25);
- vi. a spring bias means (34);
- vii. an "intended radius" (see Figs. 4 and 5).

8. Applicant should note that functional phrases occurring in the claims have been given limited patentable weight. For example, claim 4 attempts to further define apparatus structure by describing its orientation after a specific method step. Claims directed to an apparatus must be distinguished from the prior art in terms of structure rather than function. *In re Danly*, 263 F.2d 844, 847, 120 USPQ 528, 531 (CCPA 1959). "[A]pparatus claims cover what a device *is*, not what a device *does*." *Hewlett-Packard Co. v. Bausch & Lomb Inc.*, 909 F.2d 1464, 1469, 15 USPQ2d 1525, 1528 (Fed. Cir. 1990)(emphasis in original).

9. Regarding method claims 18-20 and 22-24 Hirabayashi discloses a hemming method including, either explicitly or inherently, all of the recited method steps.

Claim Rejections - 35 USC § 103

10. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

11. Claims 6, 10, 17 and 21 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi in view of Official notice.

12. These claims add mounting the die in a curved recess and applying an adhesive between the outer and inner panel. Official notice is taken of the well-known fact that adhesive is used in

² *Id.*

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hemming operations in order to improve flexibility, bonding durability and rust preventing properties. Thus, it would have been obvious to one of ordinary skill in the art to provide the hemming apparatus and method taught by Hirabayashi with adhesive between the inner and outer panel in order to improve flexibility, bonding durability and rust preventing properties of the hem.

13. Additionally, regarding the utilization of a curved recess, it would have been an obvious matter of design choice to mount the forming die in a curved recess, since the applicant has not disclosed that such a mounting solves any stated problem or is for any particular purpose.

14. Claims 11-17 and 25-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hirabayashi in view of Takatsu (4,346,579).

15. Claim 11 and 28 add the steps of moving the hemming or forming die between first and second operative positions. Takatsu discloses, in the art of hemming panels together, a hemming die that is pivotally connected to the upper body (24) via links (29, 29') and is provided with prehemming and hemming surfaces so as to bend a panel by movement of the die through two operative positions (Figs. 6 and 7). Additionally, Takatsu discloses that such an operation is less complicated than known hemming operations and thus prevents buckles, creases, wrinkles and other unwanted protuberances on the hemmed sheets (column 2, lines 5-12). Thus, it would have been obvious to one of ordinary skill in the art at the time of the invention to provide the hemming method of Hirabayashi, including the die shown in Figs. 8A-8C, with the steps of hemming by movement of the die through two operative positions in order to eliminate unwanted panel deformations, as suggested by Takatsu.

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16. Claims 12-17, 26 and 27 add limitations that are either disclosed by the references or are well-known mechanical expedients and thus obvious matters of design choice.

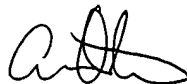
17. Claim 25 adds that the hemming tool is moved angularly. Takatsu discloses that the hemming tool is angularly movable so as to successively bend the panel into its fully bent condition. Thus, claim 25 is obvious for the same reasons as claims 11 and 28.

Conclusion

18. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Goetz whose telephone number is 703-308-1411. The examiner can normally be reached on Mon, Tues, Thurs, Fri 7:00am-5:30pm. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen Ostrager can be reached on 703-308-3136. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-3579 for regular communications and 703-305-3579 for After Final communications.

19. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-3136.

JSG
July 29, 2003



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